

ATTORNEY DOCKET NO. DB001016-001 (CREA01-00023)  
U.S. SERIAL NO. 10/619,131  
PATENT

**REMARKS**

Claims 1-7 and 28-32 are pending in the application.

Claims 1-7 and 28-32 have been rejected.

Claims 28 and 30 have been amended.

New dependent Claims 33-34 have been added.

Reconsideration of the Claims is respectfully requested.

**I. EXAMINER-INITIATED INTERVIEW**

The Examiner contacted the undersigned counsel on Wednesday, October 6, 2004 and noted five references (3 newly cited US patents and one newly cited publication) as references which may be utilized in potential new rejections. Apparently, Applicant's prior amendments resulted in overcoming all prior rejections. The Examiner then requested that the Applicant add two additional and new limitations/features including a "retaining wall" and a "tieback rod."

The undersigned counsel stated that he would try to review the multitude of new references (and the Examiner's request to introduce new and substantial elements/features into the claims) and call the Examiner to discuss on or about October 14, 2004. However, the undersigned counsel was unable to contact the Examiner on either Thursday or Friday (October 14 and 15, 2004) as planned. The undersigned counsel called the Examiner on Monday, October 18, 2004, but, the Examiner stated that she was in the middle of preparing the final office action, and thus, no further discussions took place.

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## II. REJECTION UNDER 35 U.S.C. § 112

Claims 1-7 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. The rejection is respectfully traversed.

The standard for definiteness is whether a claim reasonably apprises those of skill in the art of its scope. MPEP § 2173; *In re Warmerdam*, 33 F.3d 1354, 1361, 31 U.S.P.Q.2d 1754, 1759 (Fed. Cir. 1994). Whether the claim leaves unclear the manner in which a recited feature may be implemented is irrelevant where the claim clearly covers all forms of implementation. MPEP § 2173.02; *In re Warmerdam*, 33 F.3d 1354, 1361, 31 U.S.P.Q.2d 1754, 1759 (Fed. Cir. 1994). Determining whether a claim is indefinite requires an analysis of whether one skilled in the art would understand the bounds of the claim when read in light of the specification. MPEP § 2173.02; *Credle v. Bond*, 25 F.3d 1566, 1576, 30 U.S.P.Q.2d 1911, 1919 (Fed. Cir. 1994). The claim is not indefinite if one skilled in the art would have no particular difficulty in determining whether the recited feature has been implemented. MPEP § 2173.02; *In re Warmerdam*, 33 F.3d 1354, 1361, 31 U.S.P.Q.2d 1754, 1759 (Fed. Cir. 1994).

Independent Claims 1 and 6 clearly recite and begin with "A wale . . ." and "A retaining wall wale . . .", respectively, thus it is clear to one of ordinary skill in the art that the claim is directed to a wale.

In addition, the claims recite a wale having a channel, whereby the "channel has a depth sufficient" such that when the wale is secured to a retaining wall by a tieback rod passing

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through the wale and a fastener, the rod and fastener do not protrude from the channel. This is clearly described in the Applicant's specification (page 5, paragraph 0033). Thus, this language modifies and adequately describes the channel depth.

Accordingly, the Applicant respectfully requests withdrawal of the § 112 rejection of Claims 1-7. If the Examiner has any suggestions to modify the claim language to address the Examiner's concerns, the undersigned counsel would appreciate any such suggestions.

### III. REJECTION UNDER 35 U.S.C. § 102

Claim 28 was rejected under 35 U.S.C. § 102(b) as being anticipated by Rainey (US 6,168,351). The rejection is respectfully traversed.

A cited prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single cited prior art reference. MPEP § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

Applicant has amended independent Claim 28 to recite that the wale "is of a unitary construction." Rainey does not disclose this element/feature.

Accordingly, the Applicant respectfully requests the Examiner withdraw the § 102(b) rejection of Claim 28.

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#### IV. REJECTIONS UNDER 35 U.S.C. § 103

Claims 1, 2, 6 and 28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Weber (US 5,435,669). Claims 3, 7 and 30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Weber (US 5,435,669) in view of Fox (US 5,765,970). Claims 4, 5, 31 and 32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Rainey (US 6,168,351) in view of Enduro Systems DuroThread Fastener & Hanging System ("Enduro"). Claim 29 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Rainey (US 6,168,351). The rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d

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1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

With respect to the rejection of Claims 1, 2, 6 and 28, the Office Action appears to argue that the only difference between Applicant's independent Claims 1 and 6 is that the difference is merely "a change in the size." See, Office Action, pp 6-7. Applicant respectfully submits that the Office Action mischaracterizes the disclosure of Weber, and further, that the differences between Applicant's claims and Weber constitute significantly more than a mere "change in size" of a component.

First, Weber's panel member (87, 74) is not a "wale." The panel member (87, 74, and 14) is designed to function to form the panels (extending horizontally lengthwise) of the

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retaining wall, which are inserted into the vertical pilings. See, Abstract; Figure 1. In distinct contrast, Applicant's wale is used for bracing the retaining wall (i.e., the panels) which functions similar to the vertical piles 12, not the panel members (74, 87, 14), of Weber.

Second, the only openings through, what has been mistakenly identified by the Office Action as the "wale," are passages 81 that function to "allow for water weepage from the soil retained by the wall after installation." Col. 7, lines 47-48. No other openings through a wale are disclosed by Weber. Thus, the only openings in Weber are taught to be used for water weepage through the wall itself (i.e., the panel members) — as the vertical piles 14 in Weber function to hold the panel members (74, 87, 14), and the openings are further taught to be included on the retaining wall members, not a wale.

Third, Weber's design and method of connection of the retaining wall is substantially different from Applicant's description - Weber's panel members 14, 87, 74 are placed within the channels of the vertical piles 14 to form the panels of the retaining wall, while Applicant's panels are braced by the wale itself.

In addition, Claims 1 and 6 recite that the depth of the channel in the wale is of sufficient depth such that when the wale is secured to the retaining wall by a tieback rod passing through the wale and a fastener, the tieback rod and fastener do not protrude from the channel. The Office Action incorrectly reasons that this means merely a "change in size". It is not merely a change in size -- as the channel is designed and constructed of such a depth to prevent a

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tieback rod and fastener, when used, from protruding from the wale. See, Applicant's Figures 1A, 5.

Based upon the foregoing, there is no disclosure, teaching, suggestion or motivation to modify Weber as claimed by Applicant's in independent Claims 1 and 6 (and their dependent Claims), therefore, Applicant's claimed invention is not obvious in view of Weber.<sup>1</sup>

With respect to the rejection of dependent Claims 3, 7 and 30, Applicant reiterates from above the noted deficiencies of Weber. Further, the Office Action appears to incorrectly interpret the disclosure of the Fox reference - as Office Action mischaracterizes the wall member portions 12 of the wall 10 as a "wale". The wall member portions 12 constitute the wall portions. It is apparent that Fox's vertical whaler posts 44 stabilize and brace the retaining wall 10. Similar to Weber, Fox' design and method of connection of the retaining wall is substantially different from Applicant's description - as Fox's panel members 12 form the wall, and the vertical whaler posts 44 that brace and connect to the retaining wall 10 do not include a channel (with sufficient depth) and/or multiple openings for receiving a tieback rod. In fact, Fox utilizes "U-clips 54 which are received around the rectangular whaler posts 44 . . ." See, Col. 3, lines 20-22.

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<sup>1</sup> Claim 28 was also rejected under Section 103 over Weber. However, the Office Action fails to provide any basis or reasoning for the rejection. Nonetheless, Weber does not disclose, teach or suggest a wale having a back wall and a channel (formed in a front wall) having openings therein operable for receiving a tieback rod therethrough. As noted, Weber's openings are holes for water weepage, and are further constructed on the wall panel members - not a wale.

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Therefore, Fox fails to disclose, teach or suggest (1) a wale having a channel formed therein, and (2) wherein the channel has a sufficient depth such that when the wale is secured to the retaining wall by a tieback rod passing through the wale and a fastener, the tieback rod and the fastener do not protrude from the channel. (Applicant's dependent Claims 3 and 7). Moreover, Fox fails to disclose, teach or suggest (1) a back wall and front wall having a channel, each having an opening therein operable for receiving a tieback rod. (Applicant's dependent Claim 30).

Based upon the foregoing, there is no disclosure, teaching, suggestion or motivation to modify or combine Weber with Fox, and even assuming such combination is taught, such proposed combination fails to disclose, teach or suggest each and every element/feature of Applicant's claims.

With respect to the rejection of Claims 4, 5, 31 and 32, the Enduro reference is simply not relevant. This reference fails to disclose, teach or suggest any application to retaining walls and wales. At most, the reference discloses threaded bolts, nuts and washers made of non-metallic material, and fails to relate to a wale comprising composite material, as claimed in



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Applicant's claims.<sup>2</sup> Therefore, the Office Action has failed to establish a prima facie case of obviousness of Claims 4, 5, 31, and 32.

With respect to dependent Claim 29, as noted above, Applicant has amended the underlying independent Claim 28. As such, Rainey fails to disclose, teach or suggest each and every element/feature of dependent Claim 29.

Accordingly, the Applicant respectfully requests withdrawal of all the § 103(a) rejections of Claims 1-7 and 28-32.

V. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

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<sup>2</sup> Moreover, the Office Action has failed to establish a prima facie case of anticipation for independent Claim 1. The Office Action summarily concludes that Rainey anticipates Claim 1, but fails to particularly point out each element/feature in Claim 1 and its corresponding element/feature in Rainey. Nonetheless, for the same reasons, the Enduro reference is simply irrelevant, and there is no motivation or suggestion to combine the Enduro teachings with the Rainey reference.

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If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *rmccutcheon@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

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